

REMARKS

As an initial matter, Applicant appreciates the Examiner's reconsideration and withdrawal of all of the claim rejections included in the Office Action dated April 18, 2005. Applicant also appreciates the Examiner's indication that claims 6, 9, 14, 19, 41, 44, 49, and 51 would be allowable if rewritten in independent form, including all of the limitations of their corresponding independent claims and any intermediate, dependent claims. Office Action at 8. At this time, however, Applicant respectfully declines to rewrite any of those dependent claims in independent form, for at least the reasons explained in more detail below.

I. Claim Rejection under 35 U.S.C. § 112, Second Paragraph

In the Office Action, claims 30-35 and 58-63 were rejected under § 112, second paragraph. The rejection statement asserts that "[c]laims 30 and 58 are directed to both a product and process," and that "[a] single claim that claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, 2nd paragraph." Office Action at 2-3 (citing Ex parte Lyell, 17 U.S.P.Q.2d (BNA) 1548 (Bd. Pat. App. & Inter. 1990); M.P.E.P. § 2173.05(p)(II)).

Applicant respectfully traverses the 35 U.S.C. § 112, second paragraph, rejection of claims 30-35 and 58-63, and requests that this claim rejection be reconsidered and withdrawn. M.P.E.P. § 2173.05(p)(II) advises that "[a] single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. [§] 112, second paragraph." (Emphasis added). Applicant respectfully notes that claims 30 and 58 are not single claims that claim both an apparatus and the method of

using the apparatus, as is implicitly asserted in the rejection statement. Rather, each of Applicant's claims 30 and 58 is a method claim that includes recitations involving an apparatus. Neither claim 30 nor claim 58, however, recites both an apparatus and a method of using the apparatus. Claims 30 and 58 merely recite a method, including method steps, one of which is "providing the system of claim 1" (in the case of claim 58, "providing the system of claim 36"), in addition to reciting further method steps that relate to the system provided by the claimed method. Method claims set forth in such a manner as claims 30 and 58 have been, and continue to be, proper under U.S. patent practice, as acknowledged in, for example, M.P.E.P. § 608.01(n)(III), which provides that "[t]he fact that independent and dependent claims are in different statutory classes [(e.g., the apparatus and method classes)] does not . . . render the [dependent] claim improper." For at least these reasons, Applicant respectfully submits that the Office Action's 35 U.S.C. § 112, second paragraph, rejection of claims 30-35 and 58-63 is improper and should be withdrawn.

II. Claim Rejection under 35 U.S.C. § 101

In the Office Action, claims 30-35 and 58-63 were rejected under 35 U.S.C. § 101. In particular, the rejection statement asserts that "[c]laims 30 and 58 are directed to neither a 'process' nor 'machine' but rather embrace or overlap two different statutory classes," and that "35 U.S.C. [§] 101 is drafted so as to set forth the statutory classes of invention in the alternative only." Office Action at 3 (citing M.P.E.P. § 2173.05(p)(II)). For reasons at least similar to those outlined above with respect to the § 112, second paragraph, rejection of claims 30-35 and 58-63, the Office Action's § 101 rejection of

those claims is improper. In particular, neither claim 30 nor claim 58 recites two statutory classes of invention. Rather, each of claims 30 and 58 merely recites a method, including method steps, one of which is “providing the system of claim 1” (“providing the system of claim 36,” in the case of claim 58) in addition to reciting further method steps that relate to the system provided by the recited method. For at least these reasons, the Office Action’s 35 U.S.C. § 101 rejection of claims 30-35 and 58-63 is improper and should be withdrawn.

III. Claim Rejection under 35 U.S.C. § 103(a)

Claims 1-5, 7, 8, 10-13, 15-18, 20-40, 42, 43, 45-48, 50, and 52-71 were rejected under 35 U.S.C. § 103(a) based on Goncalves in combination with alleged, “admitted prior art” and Spielman. Applicant respectfully traverses this claim rejection under 35 U.S.C. § 103(a) at least because there is no legally proper suggestion or motivation to combine the Office Action’s asserted teachings of Goncalves, the alleged, “admitted prior art,” and Spielman in the rejection statement’s proposed, hypothetical manner.

The M.P.E.P. advises that in order to establish a *prima facie* case of obviousness, among other criteria, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference . . . [and that t]he teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, not in applicant’s disclosure.” § 2142 (citation omitted). Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” § 2143.01(III) (citation

omitted) (emphasis in original). The M.P.E.P. also advises that “[a] *prima facie* case of obviousness may . . . be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.” § 2144.05(III) (citation omitted) (emphasis added). Further, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” § 2143.01 (citation omitted).

In the rejection statement, the Examiner concedes that “Goncalves . . . lacks [a] perforating member and a blunt safety member.” Office Action at 4. The rejection statement asserts that “paragraph [003] of the instant application notes that it was common to provide [a] cap (i.e. removable stopper) with a spike capable of perforating the seal of a tube.” Id. The rejection statement thereafter concludes that “[i]t would have been obvious . . . to provide removable stopper 9 of Goncalves with a spike . . . in order to enable manual puncturing of seal 7 and thereby allow separate use of tube 2.” Id. The rejection statement also asserts that “Spielman shows that a blunt safety member 48 was an equivalent structure known in the art (see Figures 2 and 3 as compared to Goncalves, Figure 2).” Id. at 5. The rejection statement further concludes that “because these two piercing means were art-recognized equivalents . . . , . . . it [would have been] obvious to substitute the blunt safety member of Spielman for the sharp safety member of Goncalves in order to reduce the costs of fabrication.” Id.

Applicant respectfully traverses the rejection statement’s obviousness conclusions for a number of reasons. First, concerning the rejection statement’s asserted obviousness of “provid[ing] removable stopper 9 of Goncalves with a spike . . .

in order to enable manual puncturing of seal 7 and thereby allow separate use of tube 2," Applicant respectfully submits that there is no legally proper suggestion or motivation for making such a modification to the stopper 9 of Goncalves.

The Goncalves reference teaches away from the rejection statement's proposed hypothetical modification. In particular, Goncalves discloses an assembly for mixing two different products stored separately, including a tube 2 and a wide-necked pot 3, which are configured to be used together for mixing oxidation dye paste and an oxidizing paste contained respectively in the tube 2 and the wide-necked pot 3. In the "Description of the Prior Art" section, Goncalves discloses that there are numerous disadvantages to mixing oxidant and dye in a tray by dispensing dye paste from a tube and oxidant from a bottle into the tray. For example, Goncalves discloses that

Oxidation dyes are presently sold in a package containing a bottle filled with oxidant, a tube filled with a dye paste, and a light tray of thermoformed plastic material in which the oxidant and the dye paste are mixed. This package generally also contains a brush for mixing the two products in the tray and for applying the mixture to the hair strand by strand.

In view of the volume of the tray, the packages are bulky, and expensive, and they cannot be packaged manually.

....

The present invention proposes an assembly for mixing two products and for which the package and the packaging costs are substantially reduced. In order to obtain this result, mixing is accomplished in one of the containers containing one of the products.

(Col. 1, lines 16-26, 29-33.) In other words, Goncalves teaches away from separate use of a tube containing dye paste. Rather, Goncalves teaches an assembly in which the tube 2 and wide-necked pot 3 are configured such that a tearable cap 7 at one end

of the tube 2 is torn by a beveled cutting edge of collar 19 of the wide-necked pot 3 as the tube 2 is threaded onto the collar 19 of the wide-necked pot 3. Such a configuration permits the oxidation dye paste in tube 2 to be dispensed directly from tube 2 into wide-necked pot 3 for mixing within the wide-necked pot 3. As a result, the rejection statement's unsupported, hypothetical motivation for using the Goncalves tube 2 separately is contrary to the Goncalves explicit disclosure, which teaches away from separate use of the tube 2. For at least this reason, there is no legally proper suggestion or motivation to make the rejection statement's proposed, hypothetical modification to the Goncalves disclosure based on its unsupported assertion about separate use of the tube 2.

Concerning the rejection statement's asserted obviousness conclusion relating to "substitut[ing] the blunt safety member of Spielman for the sharp safety member of Goncalves in order to reduce the costs of fabrication," Applicant respectfully notes that the rejection statement has provided no reference or other prior art-based support for its asserted motivation relating to reducing the cost of fabricating the assembly of Goncalves. In fact, the rejection statement has provided no support that the asserted, hypothetical "blunt safety member of Spielman" would be less expensive to fabricate than the rejection statement's asserted, hypothetical "sharp safety member."

Furthermore, the rejection statement has not identified any disclosure supporting its assertion that "a blunt safety member 48 was an equivalent structure [to the Examiner's alleged, hypothetical 'sharp safety member']." Office Action at 5. Applicant respectfully notes that "[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot

be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents." M.P.E.P. § 2144.06 (citation omitted). In fact, the rejection statement has not provided any purported evidence to show that its equivalence assertion is recognized in the prior art. Indeed, Applicant respectfully submits that the Spielman reference teaches away from "sharp safety member[s]."

In particular, the Spielman reference discloses a removable seal 10, including a cylindrical member 11 having a first open end 12 and a second open end 14, an internal hollow portion 16, and an external male thread 18 proximate the first open end 12. The removable seal 10 further includes a screw closure 20 having a top wall 22 and a continuous side wall 24, which is attached to and extends from top wall 22. The side wall 24 is provided internally with a female thread 26 for engagement with male thread 18 of cylindrical member 11. Top wall 22 is provided with a perforate portion 28 permitting communication through top wall 22 to a flexible liquid impervious sealing member 30 or 30a.

During use, the sealing member 30 or 30a may be removed from first open end 12 by applying pressure on sealing member 30 or 30a through the perforate portion 28 of the top wall 22. When such pressure is applied, sealing member 30 or 30a disengages in its entirety from the first end 12 of the cylindrical member 11, thus permitting communication through the perforate portion 28 of top wall 22 to the hollow portion 16 of the cylindrical member 11. The pressure is applied through the perforate portion 28 of the top wall 22 by a hollow spike 48, which is provided with openings 50 to permit entry of liquid from the hollow portion 16 into the hollow spike 48 for carrying a

liquid through the hollow spike 48. The Spielman reference's hollow spike 48 is configured such that it does not pierce either seal member 30 or 30a.

In other words, the Spielman reference discloses a hollow spike 48 that disengages, rather than pierces, seal member 30 or 30a. The hollow spike 48 is not sharp because Spielman does not intend to pierce a seal. Rather, Spielman discloses disengaging a seal by pressing the hollow spike 48 against a seal member 30 or 30a that is configured to be completely disengaged rather than pierced.

In fact, Spielman discloses that

prior art seals which were broken by puncturing devices resulted in a hole in the seal which permitted liquid to flow through the hole to the exterior of the container or conduit to which the seal was applied. A serious disadvantage of this type of prior art seal is that the act of puncturing the seal results in a raised portion inside the container seal surrounding the position of the puncture. The raised portion results in a wall or dam which will hold liquid thus preventing all of the liquid from flowing through the hole in the punctured seal. This residual liquid creates a serious problem

. . . .

. . . Rather than providing a sealing member which is punctured, such as the sealing members known in the prior art, the sealing member of this invention is completely removed by the puncturing device resulting in no raised portion.

(Col. 1, lines 8-18, 54-58.) For at least these reasons, the Spielman hollow spike 48 is not an equivalent to the rejection statement's asserted, hypothetical "sharp safety member," which is intended to pierce a piercable seal. Furthermore, modifying the rejection statement's alleged, hypothetical "sharp safety member" based on Spielman's disclosure would change the principle of operation of the Examiner's hypothetical "sharp

safety member,” because instead of piercing a seal with an alleged “sharp safety member,” Spielman’s puncturing member is disclosed as being blunt to prevent piercing of a seal. As a result, someone in the rejection statement’s hypothetical field of “sharp safety member[s]” would not look to Spielman’s disclosure, which teaches away from piercing a seal. For at least these reasons, there is no legally proper motivation or suggestion to make the rejection statement’ s proposed, hypothetical modification to the rejection statement’s hypothetical “sharp safety member.”

For at least these reasons, Applicant respectfully submits that the § 103(a) claim rejection is improper. Therefore, claims 1-5, 7, 8, 10-13, 15-18, 20-40, 42, 43, 45-48, 50, and 52-71 are patentably distinguishable from Goncalves, the alleged, “admitted prior art,” and Spielman, and should be allowed.

IV. Conclusion

For at least the reasons set forth above, all of pending claims 1-71 should be allowable. Therefore, Applicant respectfully requests reconsideration of this application, withdrawal of the outstanding claim rejections, and allowance of claims 1-71.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant’s undersigned attorney at (571) 203-2739.

Applicant respectfully submits that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant declines to automatically subscribe to those assertions.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 16, 2006

By: 

Christopher T. Kent
Reg. No. 48,216